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In the Supreme Court of the United States

OCTOBER TERM, 1942

No. 763

DIXIE ROSE NURSERY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The district court delivered no opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 105–106)[1] is reported in 131 F. (2d) 446.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered

[1] Printing of the record in this case has been dispensed with upon petitioner's motion. The record citations therefore refer to the typewritten transcript of the record filed with this Court.

November 16, 1942 (R. 107). A petition for rehearing was denied December 23, 1942 (R. 108). The petition for a writ of certiorari was filed February 25, 1943. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

Whether, in the circumstances of this case, the Commissioner of Patents improperly refused to issue a certificate of registration of a trade-mark for rose plants, scions, and cuttings, consisting of the words "Texas Centennial" imposed upon a crude map outline base approximating the outline of the State of Texas.

STATUTE INVOLVED

Section 5 of the Trade Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 726; 15 U. S. C. § 85) provides in part:

> * * * *Provided,* That no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, * * * or merely a geographical name or term, shall be registered under the terms of this Act: * * *

STATEMENT

Petitioner owns Plant Letters Patent No. 162, dated January 21, 1936, covering a certain variety of rose plant listed in petitioner's catalogue

by the name "Texas Centennial" (R. 45, 47). This variety of rose is known throughout the trade, and purchasers call for it and for no other variety by that name (R. 45, 46). The rose is apparently grown and marketed only by petitioner and its licensees (R. 45), and although some licensees have agreed to tell purchasers of petitioner's connection with the rose, one may in fact buy "Texas Centennial" roses without learning that the original rose stock came from petitioner's nursery (R. 51, 74).

On April 24, 1936, petitioner filed in the United States Patent Office a formal application for the registration of its trade mark for rose plants, scions, and cuttings, under the provisions of the Trade Mark Act of February 20, 1905, c. 592, 33 Stat. 724, as amended (15 U. S. C. § 81). The mark consisted of the words "Texas Centennial" imposed upon a crude map outline base approximating the outline of the State of Texas, and the application alleged commencement of the use of the mark in interstate commerce on November 1, 1935. After full consideration, the Commissioner of Patents rejected the application on the grounds that "Texas Centennial" was the name of the variety of rose involved and thus "descriptive" of the plant, and that the name and map of Texas were "geographical," within the meaning of the

proviso in Section 5 of the Act. (*Supra,* p. 2 Pet. Ex. 1; Resp. Ex. 1; 45 USPQ 673; 46 USPQ 525.)

Petitioner thereupon brought this suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes, as amended (35 U. S. C. § 63),[2] to direct the respondent, the Commissioner of Patents, to issue to petitioner a certificate of registration of its trade-mark, which the complaint alleged respondent had unjustly refused (R. 1–4). After a trial, the district court dismissed the complaint (R. 9), finding as facts that "Texas Centennial" was the variety name descriptive of the rose cov-

[2] This section, authorizing proceedings in the Federal district courts to review a refusal by the United States Patent Office to issue a patent on application, has been held also to be applicable to refusal by the Patent Office of an application for trade-mark registration. *Hygienic Products Co.* v. *Coe*, 85 F. (2d) 264, 266 (App. D. C.); *Tomlinson of High Point* v. *Coe*, 123 F. (2d) 65 (App. D. C.); see *Baldwin Co.* v. *Robertson*, 265 U. S. 168, 179–181. This remedy is apparently the result of Section 9 of the Trade Mark Act (15 U. S. C. § 89), which authorizes applicants for registration of a trade-mark to appeal from an adverse decision of the Commissioner of Patents to the United States Court of Customs and Patent Appeals, and which made applicable to trade-mark cases the conditions, rules of practice and procedure governing appeals to that Court in patent cases. Section 9 has been read to manifest an intention to make available in respect to trade-marks every remedy afforded in patent proceedings. *Procter & Gamble Co.* v. *J. L. Prescott Co.*, 102 F. (2d) 773, 782, *et seq.* (C. C. A. 3), certiorari denied, 308 U. S. 557.

ered by Plant Patent No. 162 and had not been applied to any other plant (R. 7), and that the licensees of petitioner in selling roses of the "Texas Centennial" variety were not required to indicate that petitioner supplied the original plant (R. 7). The court then concluded that "Texas Centennial" was not registrable under the Trade-Mark Act of 1905 because it was descriptive of the roses to which it applied, and that the word "Texas" and the outline map of the State of Texas were not entitled to registration because merely geographical (R. 8).[3] The court below affirmed the judgment of the district court (R. 107), holding that since the Patent Office and the district court might properly have concluded that the words "Texas Centennial" described to the public a rose of a particular sort and not a rose from a particular nursery, registration of the trade-mark was properly denied even though, by virtue of its patent, petitioner and its licensees were the only ones who for the moment produced the rose (R. 105, 106).

ARGUMENT

Under the common law, the function of a trade-mark was to indicate the source of the particular product to which the mark was applied (*Elgin*

[3] The district court also held that refusal to register "Texas" and the state map was justified because of petitioner's failure to disclaim them under Section 4917 of the Revised Statutes (35 U. S. C. § 65); see *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, 545.

National Watch Co. v. *Illinois Watch Co.,* 179 U. S. 665, 673); consequently, words which were merely descriptive or geographical were not proper trade-marks. *Canal Company* v. *Clark,* 13 Wall. 311, 323 ("Lackawanna" coal); *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.,* 138 U. S. 537, 546 ("LL" for sheetings). This principle was restated in Section 5 of the Trade Mark Act of 1905, prohibiting the registration of words or devices that are merely descriptive of the goods with which they are used, or are merely geographical (*supra,* p. 2). The decisions construing this section clearly establish that the name of the product involved is a "descriptive" word and hence not registrable under the 1905 Act. *Kellogg Company* v. *National Biscuit Co.,* 305 U. S. 111, 116 ("Shredded Wheat"); *A. B. Humphrey Co.* v. *Arkelian,* 34 F. (2d) 749 (C. C. A. 9) ("Lady Finger Grapes"). While the name of a particular article may acquire the secondary meaning of the source of the article and thereby become a proper trade-mark (*cf. Speaker* v. *Shaler Co.,* 87 F. (2d) 985 (C. C. A. 7), certiorari denied, 301 U. S. 695 ("Hot Patch" as applied to rubber vulcanization)), the test to be applied in determining the term's eligibility for registration as a trade-mark is its meaning to the buying public. *Du Pont Cellophane Co.* v. *Waxed Products Co.,* 85 F. (2d) 75, 77 (C. C. A. 2), certiorari denied, 299 U. S. 601; *Bayer Co.* v. *United Drug Co.,* 272 Fed. 505, 509 (S. D. N. Y.). These well es-

tablished principles of trade-mark law were correctly applied by the Patent Office and the court below.

1. The district court found that the words "Texas Centennial" meant to the purchasers of roses the name of a particular variety of rose and not the source of the variety. Consequently, it concluded that the proposed trade-mark was descriptive and not entitled to registration. Contrary to petitioner's contention (Pet. 12, 24–26), this finding is adequately supported by the evidence. The American Rose Annual of 1936 lists "Texas Centennial" as a variety name of the rose in question (R. 84, Resp. Ex. 2) and similar listings are given in issues of the publication "Success with Roses" (R. 84, Resp. Exs. 3, 4). Indeed, one of petitioner's own witnesses, a member of his firm, unequivocally testified that "Texas Centennial" was the name of a particular variety of rose and had never been applied to any other (R. 41), and that the company's intention in adopting that name was to identify the plant therewith (R. 44).

The findings below that "Texas Centennial" does not describe the source of the rose is likewise supported by the evidence. One of petitioner's witnesses, the vice president of a licensee company, testified that his company was not required to tell its customers for "Texas Centennial" roses that the plant originated with the Dixie Rose Nursery, and that in some cases they did not so

inform them (R. 74). And a member of petitioner's firm testified that "Texas Centennial" roses could be purchased from licensees without the purchaser being informed that they came from petitioner's nursery (R. 50).

Petitioner's contention that the real name of the rose is "Red Hoover" and not "Texas Centennial" (Pet. 12) is without substance, for one of its witnesses testified that a "Red Hoover" rose "really is" a "Texas Centennial" (R. 46), and petitioner's own catalogue stated that the rose "Texas Centennial" was "a sport of the noted rose, President Herbert Hoover" (Pet. Ex. 9).

Petitioner has obviously failed to sustain his burden of showing by clear and convincing evidence that the decision of the Commissioner of Patents denying registration was erroneous. *Century Distilling Co.* v. *Continental Distilling Co.*, 106 F. (2d) 486 (C. C. A. 3), certiorari denied, 309 U. S. 662. And since the findings of the district court are supported by the evidence, their affirmance below was proper. Cf. *Sharp* v. *Coe*, 125 F. (2d) 185, 189 (App. D. C.) (patent registration). That the Patent Office may have registered other trade-marks which are claimed to be more descriptive than petitioner's (Pet. 28–32) is irrelevant. The issue presented is the correctness of the refusal to register in the instant case; administrative errors committed in other cases cannot change the law. *In re Ric-Wil Co.*, 87 F. (2d) 516, 517 (C. C. P. A.).

2. No importance attaches to the fact that the product for which the trade-mark was rejected was patented (Pet. 12, 37). Nothing in the Trade Mark Act of 1905 or in the judicial interpretation thereof indicates any intention to exempt a patent owner from any of its requirements; and the privilege of registering a patented article is the same as if the article were not patented. See *President Suspender Co.* v. *Macwilliam,* 238 Fed. 159, 163 (C. C. A. 2), certiorari denied, 243 U. S. 636; *Bayer Co.* v. *United Drug Co.,* 272 Fed. 505, 509 (S. D. N. Y.). Petitioner's rose is not to be denied trade-mark registration merely because the plant is covered by a patent, but it is not entitled to a trade-mark that is merely descriptive. *In re Pitney-Bowes Postage Meter Co.,* 6 F. (2d) 717, 718 (App. D. C.); see *Leclanche Battery Co.* v. *Western Electric Co.,* 23 Fed. 276, 277 (C. C. S. D. N. Y.).

3. There is no merit in petitioner's contention (Pet. 21–23) that its composite trade-mark taken as a whole is registrable under Section 5 of the Trade Mark Act of 1905. While a composite mark should be considered as a whole in determining its registerability (*In re Pierce Arrow Motor Car Co.,* 55 F. (2d) 434, 436 (C. C. P. A.)), a registrable mark cannot be formed merely by combining two nonregistrable features (*In re Meyer Bros. Coffee & Spice Co.,* 32 App. D. C. 277, 278). A mere geographical figure may not be registered as a trade-mark (*In re Canada*

Dry Ginger Ale, 86 F. (2d) 830 (C. C. P. A.) (map of Canada); see *Hoyt* v. *J. T. Lovett Co.,* 71 Fed. 173 (C. C. A. 3)), and, as already shown, neither may descriptive words alone. Petitioner's combination of descriptive words and geographical figure in no way changes the significance of either component; consequently the mark considered as a whole is not registrable under the statute. *In re Canada Dry Ginger Ale,* 87 F. (2d) 736, 737 (C. C. P. A.) ("Canada Dry" superimposed on map of Canada); *In re Midy Laboratories,* 104 F. (2d) 617, 618 (C. C. P. A.).[4]

CONCLUSION

The decision below is correct. There is no conflict of decisions and no question of general importance is presented. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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MARCH 1943.

[4] Since petitioner's composite mark is clearly nonregistrable, it is unnecessary to discuss its contention that where a trade-mark as a whole is not merely descriptive or geographical, disclaimer of the descriptive or geographical features is not a prerequisite to registration (Pet. 12, 34–35).

U. S. GOVERNMENT PRINTING OFFICE: 1943